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OFFICE OF PETITIONS

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Docket No: 7755/0D276

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Fiona Catherine MILLAR

Serial No.: 08/999,752

Art Unit: 1615

Filed: June 4, 1997

Examiner: R. Bawa

For: MEDICINAL AEROSOLS AND METHODS OF DELIVERY THEREOF

PETITION UNDER 37 C.F.R. 1.181(a) REQUESTING
WITHDRAWAL OF A HOLDING OF ABANDONMENT

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

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Sir:

TECH CENTER 1600/2900

Applicant hereby petitions the U.S. Patent and Trademark Office to reconsider the holding of abandonment as set forth in the Notice of Abandonment, Paper No. 17 dated June 21, 2000. It is respectfully submitted that the ground for abandonment stated in the Notice is incorrect in that the Supervisory Examiner vacated the Final Rejection (Office letter) in question as noted in his Interview Summary of June 1, 2000.

The facts leading to vacating the Final Rejection are set forth in the Declaration of Bert J. Lewen attached hereto. There does not appear to be any dispute that the Supervisory Examiner submitted this document to the applicant's attorney on that date. For the following reason, it is respectfully submitted that the Supervisory Examiner had the authority to so withdraw the Final Rejection:

MPEP ¶706.07(e), third paragraph, specifically states:

The examiner may withdraw the rejection of finally rejected claims.... Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.

Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious. Normally, the previous rejection should be withdrawn with respect to the claim or claims involved.

In the instant case, as set forth in the Declaration of Bert J. Lewen, applicant was advised initially that the Examiner was aware of better prior art and subsequently, during a telephone conference, specifically advised of the references which the Examiner considered more pertinent. Accordingly, it is respectfully submitted that the Examiner had the authority to so withdraw (vacate) the Final Rejection and that applicant had the right to rely on such withdrawal upon the receipt of written notification from the Supervisory Examiner, with the expectation that a new ground of rejection would be forthcoming.

In view of the foregoing, it is respectfully submitted that, in light of the Examiner's vacating of the Final Rejection, the holding of abandonment should be withdrawn and that no response to such rejection is or was properly due.

Since the subject Petition is under 37 C.F.R. 1.181(a), no fee is required to accompany this Petition. On the other hand, should the USPTO deem that the application was properly abandoned, it is respectfully requested that this document alternatively be construed as a Petition under 37 C.F.R. 1.137 and charge the necessary fee to applicant's attorney's Deposit Account No. 04-0100.

Respectfully submitted,

Dated: July 18, 2000



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